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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

614.1948

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on 8-12-05

Signature R. P. Adams

Typed or printed name Renée P. Adams

Application Number

09/271,249

Filed

3/17/1999

First Named Inventor

TAKASHI SHINZAKI, et al.

Art Unit

2132

Examiner

GURSHMAN, GRIGORY

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒ attorney or agent of record.
Registration number 22,010

☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

Signature

H.J. Staas

Typed or printed name

202-434-1500

Telephone number

Aug. 12, 2005

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Docket No.: 614.1948

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:
Takashi SHINZAKI et al.

Serial No. 09/271,249

Group Art Unit: 2132

Filed: March 17, 1999

Examiner: Grigory Gurshman

For: AUTHENTICATION APPARATUS AND COMPUTER-READABLE STORAGE MEDIUM

PRE-APPEAL BRIEF

Mail Stop AF

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

I. A SIGNIFICANT OPERATING FEATURE OF THE PRESENT INVENTION, WHICH IS EXPRESSLY SET FORTH IN THE REJECTED CLAIMS, IS ALTOGETHER IGNORED BY THE EXAMINER

The present invention addresses a problem of prior art biometric verification systems which use registered biometric information of authorized individual, for verification of that individual at a verification facility. Particularly, the biometric information may be stolen or leaked to third parties and be used by them to the severe disadvantage of the involved individual. (Application, pages 1-4).

By contrast, the system of the invention "positively" prevents this by processing the biometric information, at least through a conversion process (and preferably also a feature extraction process) such that only the converted biometric information (and typically only extracted features thereof) is employed at the verification facility. The converted information, even if stolen or leaked, is of no use to a third party. (Specification at pages 4-9 and 11-15, inter alia; see also, R1¹ filed July 13, 2003 at pages 6-7 and 10-11.) (The conversion and extraction functions may be reversed). (Specification, page 19 and 38).

The cited references to Kanevsky and Priddy are susceptible to the very same

¹ The USPTO Pre-Appeal Brief guidelines specify that the Paper Number and pages thereof, of documents in the prosecution history, should be cited. However, the Office Actions received by Applicants have no Paper Numbers nor are they routinely indicated in the PAIR record. Hence, Applicants have adopted designations OA1 through OA6 for successive Office Actions, AA for Advisory Action and R1-R5 for the Responses herein. A print out of the PAIR listings for the subject application is attached as Exhibit A and the Papers as identified thereon are annotated with their respective R, OA and AA designations.

deficiencies of the admitted prior art (Response¹ filed July 21, 2003, pages 1-4), since neither of the cited references to Kanevsky and Priddy teaches carrying out a verifying process using encrypted data; instead, each must decrypt the encrypted data back to the original data form in order to carry out verification. (R2 filed July 21, 2003 at pages 11-14). The cited reference to Strait likewise has no such teaching of converting and extracting features of biometric data and performing verification using same - - although the Examiner attempts improperly to suggest such a teaching is present in Strait (R5 at pages 11-13 and see also Section III, infra).

II. THE EXAMINER HAS INAPPROPRIATELY GROUPED THE CLAIMS, RENDERING THE REJECTIONS ILLOGICAL

The Examiner segregated the independent claims into three groups (OA3 mailed October 2, 2003, in Item 3, pages 2-3 and 8-9).

Applicants challenged the Examiner's groupings of the pending claims, since claims with different limitations were grouped together while claims with common limitations were put in different groups - - and proposed a reorganization of the claims to be consistent with their respective recitations and the sequences thereof. (R3 of February 2, 2004 at page 2-3 and pages 8-9).

The Examiner responded (OA4 of March 3, 2004, page 2, Item 3), asserting only that a "broad but reasonable interpretation of the claim has been applied and claims have been grouped according to their scope and subject matter..." - - but without explaining that "interpretation".

Applicants responded, again objecting and presenting a detailed demonstration of proper groupings of the claims - - abbreviating the functions, generally recited in the claims, of measuring, converting, extracting, registering, verifying (and a modified verifying) as M, C, E, R, V (and V¹), respectively, and then grouped claims of a common sequence of common functions in a respective, common group. (R5 of August 3, 2004 at pages 2-3 and attached Table). The Examiner's response was to assert not only that "comparing and verification is the same function" but also that:

...[T]he process of verification recited in all of the independent claims 1, 19, 27, and 9, 22, 28 is the same and produces the same result regardless of the order of steps performed prior to verification.

(AA mailed September 23, 2004 in part 2.2) The Examiner then "pointed out" that:

...[V]erification is performed by comparison of a biometric sample information in the corresponding form previously obtained and stored.

[F]or the purpose of comparing two pieces of biometric information it is irrelevant whether these pieces are extracted converted portions of biometric information or converted biometric samples.

(AA at page 3)

Likewise, in the final rejection mailed May 12, 2005 at page 9, the Examiner asserts that, with regard to the terminology of Applicant's claims:

all of the functional steps performed are used for accomplishing one thing verification of the biometric information and thereby authenticating an individual...[T]he process of verification recited in all of the independent claims...is the same and produces the same result regardless of the order of steps performed prior to verification.

(Emphasis added)

The Examiner either ignores, or does not understand, the important distinction of the present invention over the prior art, discussed in §I, supra - - and that "biometric information" is not registered and used herein for verification.

Nowhere does the Examiner cite any authority justifying his wholesale disregard of the claim limitations as to functions performed and the order thereof, as well as the special character of the registered information at a verification facility. Applicants submit that it is hornbook law that the Examiner's treatment of the claims is improper.

III. THE EXAMINER MODIFIES THE STRAIT DESCRIPTIONS BY INSERTING THEREIN TERMS OF APPLICANT'S CLAIMS - - AND THEN RELIES ON THE REWRITTEN DESCRIPTIONS TO REJECT THE CLAIMS - - AND EVEN FOR "MOTIVATION"

The Examiner inserted Applicants' claim terms "extracting" and "converting" into a purported quotation from the Strait reference, as though synonyms of Strait's terms "recording" and "convolving", respectively. (OA3 mailed October 2, 2003 page 4). Applicants challenged that tactic as inappropriate and inaccurate, pointing out that Strait did not use those terms of Applicants' claims and that, instead, the Strait terms had definitions diametrically opposed to Applicant's respective claim terms, as evidenced by dictionary definitions. (R3 filed February 2, 2004, page 3-5 and Exhibits A and B).

The Examiner repeated and relied upon his distorted quotation of Strait (OA4 mailed March 3, 2004, pages 2-4), which Applicant again disputed (R4, Item 5 at pages 6-8) - - and then he expanded on same to assert that Strait teaches "verifying the converted biometric information by comparing the error correcting code words produced from the convolved biometric measurements (i.e., converted extracted feature biometric information)...." (Emphasis added).

(OA5 at pages 2-3). The Examiner further asserted:

Examiner maintains that one of ordinary skill in the art would have been motivated to verify the extracted feature converted biometric information by comparing it against the extracted feature converted biometric information previously obtained as taught in Strait for securing a cryptographic system based on biometric measurements (see Strait, col. 2, lines 60-65).

Examiner points out that the motivation to combine the teachings of Kanevsky and Strait is explicitly provided in Strait (col. 2, lines 60-65).

(OA5 at page 3)

The Examiner, self-apparently, now relies on his rewritten description of Strait, using Applicants' claim terminology, as the motivation to combine the teachings of Kanevsky and Strait in support of the 35 U.S.C. §103 rejection of Applicants' claims. That is not the teaching of Strait (R5 at pages 12-13 but prohibited hindsight: *In re Rouffet*, 47 USPQ2d 1453, 1457; see also MPEP §2143.01); moreover, Strait at col. 2, lines 60-65 affords no basis for the alleged "motivation"; but merely states:

A further advantage of the present invention is that a method and system are provided for securing a cryptographic system based on biometric measurements.

(Strait at col. 2, lines 60-65 and R5 at page 13). This describes, at best, the admitted prior art - - and is irrelevant to the invention of Applicants' rejected claims.

CONCLUSION

The history of rejections herein run counter to the mandate of the Federal Circuit Court, that "the definition of claim language should be obtained by the language of the specification, (Phillips v. AWH Corp., (Fed. Cir. 2005) (en banc), Appeal No. 03-1269, - 1286, July 12, 2005) Dictionaries can be used as extrinsic evidence, but the definition is "less significant" than what is provided in the specification. (Phillips, page 18).

The Examiner herein has ignored Applicants' specification and the dictionary evidence presented to him, has asserted his right to disregard material claim limitations and has distorted the teachings of the references to mount unsupported rejections - - and also failed to cite appropriate grounds of motivation.

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The rejections are without basis and should be withdrawn.

Respectfully submitted,

STAAS & HALSEY LLP

Date: August 12, 2005

By: 

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CERTIFICATE UNDER 37 CFR 1.8(a)

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STAAS & HALSEY

By: Brian P. Adams

Date: 8-12-05

EXHIBIT A

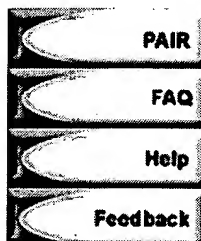
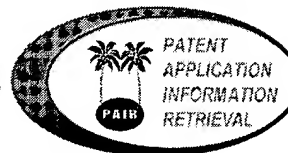




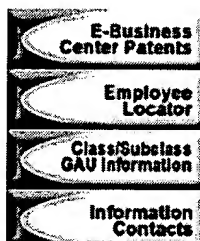
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PATENT APPLICATION INFORMATION RETRIEVAL



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Search results as of: 8-10-2005::19:17

Search results for application number:09/271,249			
Application Number:	09/271,249	Customer Number:	21171
Filing or 371(c) Date:	03-17-1999	Status:	Final Rejection Mailed
Application Type:	Utility	Status Date:	05-12-2005
Examiner Name:	GURSHMAN, GRIGORY	Location:	ELECTRONICS
Group Art Unit:	2132	Location Date:	-
Confirmation Number:	3857	Earliest Publication No:	-
Attorney Docket Number:	614.1948	Earliest Publication Date:	-
Class/ Sub-Class:	713/182	Patent Number:	-
First Named Inventor:	TAKASHI SHINZAKI, KAWASAKI-SHI, (JP)	Issue Date of Patent:	-
Title Of Invention:	AUTHENTICATION APPARATUS AND COMPUTER-READSTORAGE MEDIUM		

Select Search Option

Assignments
Display References
Foreign Priority
Image File Wrapper
Publication Review

File History		
Date	Contents Description	
05-12-2005	Mail Final Rejection (PTOL - 326)	0A6
05-11-2005	Final Rejection	
03-23-2005	Date Forwarded to Examiner	
03-21-2005	Response after Non-Final Action	R5
03-21-2005	Request for Extension of Time - Granted	
10-20-2004	Mail Notice of Withdrawn Action	
10-20-2004	Mail Non-Final Rejection	0A5
10-15-2004	Non-Final Rejection	
10-15-2004	Letter Withdrawing / Vacating Office Action	
09-23-2004	Mail Advisory Action (PTOL - 303)	AA
09-20-2004	Advisory Action (PTOL-303)	
08-05-2004	Notice of Appeal Filed	
09-07-2004	Date Forwarded to Examiner	
08-05-2004	Amendment after Final Rejection	R4

08-05-2004	Request for Extension of Time - Granted	
03-03-2004	Mail Final Rejection (PTOL - 326)	OA 4
03-02-2004	Final Rejection	
02-12-2004	Date Forwarded to Examiner	
02-04-2004	Response after Non-Final Action	R3
02-04-2004	Request for Extension of Time - Granted	
10-02-2003	Mail Non-Final Rejection	OA3
09-29-2003	Non-Final Rejection	
09-11-2003	Preliminary Amendment	R2'
08-12-2003	Examiner Interview Summary Record (PTOL - 413)	
07-29-2003	Date Forwarded to Examiner	
07-29-2003	Date Forwarded to Examiner	
07-23-2003	Request for Continued Examination (RCE) with Prel Amt	R2
07-29-2003	DISPOSAL FOR A RCE/CPA/129 (express abandonment if CPA)	
07-23-2003	Request for Extension of Time - Granted	
07-23-2003	Workflow - Request for RCE - Begin	
02-19-2003	Mail Final Rejection (PTOL - 326)	
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01-21-2003	Incoming Letter Pertaining to the Drawings	
01-28-2003	Date Forwarded to Examiner	
01-21-2003	Response after Non-Final Action	R1
01-21-2003	Request for Extension of Time - Granted	
01-21-2003	Request for Extension of Time - Granted	
08-12-2002	Mail Non-Final Rejection	OA 1
08-08-2002	Non-Final Rejection	
07-24-2002	Case Docketed to Examiner in GAU	
01-28-2002	Case Docketed to Examiner in GAU	
11-06-2001	Case Docketed to Examiner in GAU	
10-06-2000	Case Docketed to Examiner in GAU	
07-14-2001	Case Docketed to Examiner in GAU	
10-06-2000	Case Docketed to Examiner in GAU	
03-17-1999	Information Disclosure Statement (IDS) Filed	
03-17-1999	Request for Foreign Priority (Priority Papers May Be Included)	
04-28-1999	Case Docketed to Examiner in GAU	
04-02-1999	Application Dispatched from OIPE	
03-30-1999	IFW Scan & PACR Auto Security Review	
03-22-1999	Initial Exam Team nn	

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